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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,503	12/13/2005	Hidekazu Inoue	69681.000005	4612

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EXAMINER	
MURRAY, JEFFREY H	

ART UNIT	PAPER NUMBER
1624	

MAIL DATE	DELIVERY MODE
08/05/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/560,503	INOUE ET AL.	
	Examiner	Art Unit	
	JEFFREY H. MURRAY	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1, 2, and 4-11 are pending in this application. Claim 3 has been withdrawn. This action is in response to the applicants' amendment and reply after a non-final filed on April 25, 2008. Claim 3 stands withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Election was made **without** traverse in the reply filed on April 25, 2008.

Withdrawn Rejections/Objections

3. Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

Claim Objections

2. Claim 1 is objected to as containing subject matter drawn to a non-elected invention, specifically the imidazotriazinone compounds of formula (IB). A complete reply to the final rejection must include cancellation the of nonelected subject matter or other appropriate action. Applicant is advised that should claim 10 be found allowable, claim 11 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112, 1st paragraph

5. Claims 1, 2 and 4-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a compound, composition or pharmaceutically acceptable salt, does not reasonably provide enablement for a solvate of the compounds claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make solvates or to use solvates of the compounds claimed commensurate in scope with these claims.

The test of enablement is whether one skilled in the art could make and use the claimed invention from the disclosures in the application coupled with information known in the art without undue experimentation. (*United States v. Teletronics* Inc., 8 USPQ2d 1217 (Fed. Cir. 1988)). Whether undue experimentation is needed is not based on a single factor, but rather a conclusion reached by weighing many factors (See *Ex parte Forman* 230 USPQ 546 (Bd. Pat. App. & Inter. 1986) and *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988).

These factors include the following:

1) *Amount of guidance provided by Applicant.* Applicant has provided no guidance, examples, or provided data and/or testing results of any solvates in the current application.

2) Unpredictability in the art. It is well established that "the scope of enablement varies inversely with the degree of unpredictability of the factors involved", and physiological activity is generally considered to be an unpredictable factor. (USPQ 18, 24 (CCPA 1970). See *In re Fisher*, 427 F.2d 833, 839, 166.

Chemistry is unpredictable. *See In Re Marzocchi and Horton* 169 USPQ at 367 paragraph 3:

> "Most non-chemists would probably be horrified if they were to learn how many attempted syntheses fail, and how inefficient research chemists are. The ratio of successful to unsuccessful chemical experiments in a normal research laboratory is far below unity, and synthetic research chemists, in the same way as most scientists, spend most of their time working out what went wrong, and why. Despite the many pitfalls lurking in organic synthesis, most organic chemistry textbooks and research articles do give the impression that organic reactions just proceed smoothly and that the total synthesis of complex natural products, for instance, is maybe a labor-intensive but otherwise undemanding task. In fact, most syntheses of structurally complex natural products are the result of several years of hard work by a team of chemists, with almost every step requiring careful optimization. The final synthesis usually looks quite different from that originally planned, because of unexpected difficulties encountered in the initially chosen synthetic sequence. Only the seasoned practitioner who has experienced for himself the many failures and frustrations which the development (sometimes even the repetition) of a synthesis usually implies will be able to appraise such work .....Chemists tend not to publish negative results, because these are, as opposed to positive results, never definite (and far too copious)" Dorwald F. A. *Side Reactions in Organic Synthesis*, 2005, Wiley: VCH, Weinheim pg. IX of Preface.

The scope of "solvate" is not adequately enabled or defined. Applicants provide no guidance as how the compounds are made more active *in vivo*. Solvates cannot be predicted and therefore are not capable of being claimed if the applicant cannot properly enable a particular solvate.

> "Predicting the formation of solvates or hydrates of a compound and the number of molecules of water or solvent incorporated into the crystal lattice of a compound is complex and difficult. Each solid compound responds uniquely to the possible formation of solvates or hydrates and hence generalizations cannot be made for a series of related compounds. Certain molecular shapes and features favor the formation of crystals without solvent; these compounds tend to be stabilized by efficient packing of molecules in the crystal lattice, whereas other crystal forms are more stable in the presence of water and/or solvents. There may be too many possibilities so that no computer programs are currently available for

predicting the crystal structures of hydrates and solvates. Vippagunta et. al. Advanced Drug Delivery Reviews 48 (2001) 3-26.

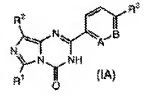
The scope of any compounds where the R variables are not those previously described above is not adequately enabled or defined. Applicants have provided no guidance as how the compounds are made more active *in vivo*.

Applicants have argued that their specification teaches how to make solvates. This is not found persuasive. Merely stating, "Further, the compounds of the present invention may include hydrate or solvate with water, ethanol or isopropanol, and polymorphisms thereof." is in no way a teaching, guidance, an example, or data and/or testing results. It is merely a prophetic statement. While Vippagunta teaches acceptable practices on characterizing solvates, it stresses that they are "complex and difficult." As mentioned, certain formations favor forming crystal lattices while others may prefer a solvent or water to be present. There is no way to predict this and no such computer programming currently exists. To run thousands of experiments on all of the potential imidazotriazinone derivatives would pose an undue burden.

3) *Number of working examples.* The compound core depicted with specific substituents represent a narrow subgenus for which applicant has provided sufficient guidance to make and use; however, this disclosure is not sufficient to allow extrapolation of the limited examples to enable the scope of the compounds instantly claimed or preventive agents. Applicant has provided no working examples of any compounds, compositions or pharmaceutically acceptable salts which have been converted into solvates.

Within the specification, "specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. *Markush* claims must be provided with support in the disclosure for each member of the *Markush* group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula." See MPEP 608.01(p).

4) *Scope of the claims*. The scope of the claims involves all of the thousands of compounds and compositions of Formula (IA):



(IA)

and all of the potential solvates it could form with any known organic solvent, thus, the scope of claims is very broad.

5) *Nature of the invention*. The present invention relates to imidazotriazinone compounds, pharmaceutically acceptable salts and solvates thereof, having PDE 7 (phosphodiesterase VII) inhibiting effect. These compounds are effective compounds for treating various kinds of disease such as allergic disease, inflammatory disease and immunologic disease.

6) *Level of skill in the art*. The artisan using Applicants invention would be a chemist with a M.S. or Ph.D. degree, and having several years of bench experience.

MPEP §2164.01 (a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here that Applicant is not enabled for making these compounds or compositions or treating the diseases mentioned.

6. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a compound, composition or pharmaceutically acceptable salt, does not reasonably provide enablement for a PDE 7 inhibitor. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. In view of the lack of a definition of the term "PDE 7 inhibitor" one could interpret this as a compound or a composition which raises issues of enablement.

The test of enablement is whether one skilled in the art could make and use the claimed invention from the disclosures in the application coupled with information known in the art without undue experimentation. (*United States v. Teletronics* Inc., 8 USPQ2d 1217 (Fed. Cir. 1988)). Whether undue experimentation is needed is not based on a single factor, but rather a conclusion reached by weighing many factors (See *Ex parte Forman* 230 USPQ 546 (Bd. Pat. App. & Inter. 1986) and *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988).

These factors include the following:

1) *Amount of guidance provided by Applicant.* Applicant has not provided any guidance, examples, or provided any chemical or biological data and/or testing results of any PDE 7 inhibitors.

Applicants have not provided any definition within the specification to any extent as to what is encompassed by "a PDE 7 inhibitor" in the current application. An applicant must clearly identify these things. In the instance of a PDE 7 inhibitor, applicant must explain what the inhibitor is, as it cannot possibly be "any therapeutic agent known to man. What is the definition? Are we to interpret these agents as anything? Applicant certainly cannot "reach through" and claim therapeutic agents and drugs that have not even been discovered yet. Applicant must also define what the delivery of the therapeutic agent is intended to treat, and how it is to treat.

2) *Unpredictability in the art.* It is well established that "the scope of enablement varies inversely with the degree of unpredictability of the factors involved," and physiological activity is generally considered to be an unpredictable factor. (USPQ 18, 24 (CCPA 1970). See *In re Fisher*, 427 F.2d 833, 839, 166.

3) Number of working examples. The composition core depicted with specific substituents represents a narrow subgenus for which applicant has provided sufficient guidance to make and use; however, this disclosure is not sufficient to allow extrapolation of the limited examples to enable the scope of the composition instantly claimed or preventive agents. Applicant has provided no working examples of any PDE 7 inhibitors".

Within the specification, "specific operative embodiments or examples of the

invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. *Markush* claims must be provided with support in the disclosure for each member of the *Markush* group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula." See MPEP 608.01(p).

4) *Scope of the claims*. The scope of the claims involves various substituted imidazotriazinones and their potential use as a PDE 7 inhibitor, thus, the scope of claims are very broad.

5) *Nature of the invention*. The present invention relates to imidazotriazinone compounds, pharmaceutically acceptable salts and solvates thereof, having PDE 7 (phosphodiesterase VII) inhibiting effect. These compounds are effective compounds for treating various kinds of disease such as allergic disease, inflammatory disease and immunologic disease.

6) *Level of skill in the art*. The artisan using Applicants invention would be a doctor with an M.D. degree, and having several years of professional experience.

MPEP §2164.01 (a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That

conclusion is clearly justified here that Applicant is not enabled for making these compounds or compositions or treating the diseases mentioned.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Conclusion

7. Claims 1, 2, and 4-11 are rejected.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is (571) 272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/
Patent Examiner
Art Unit 1624

/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624